

REMARKS

Claims 1-26 are pending in the present application. Claim 8 was previously cancelled without prejudice in a Preliminary Amendment dated March 8, 2006.

In the above referenced Non-Final Office Action the Examiner has made the following actions as further described below.

Claim Rejections

The Examiner has rejected claims 1-26 in the manner discussed below. Applicant respectfully traverses.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 14-17 under 35 U.S.C. § 112, first paragraph, as assertedly failing to comply with the written description requirement.

More specifically, with respect to claims 14 and 15, the Examiner asserts that the written description fails to disclose the limitation of "the expert being precluded from obtaining information regarding the outcome of the claim."

In reply, Applicant notes that the Specification explicitly states that "[a]t all times the neutral third party keeps information about the parties in the strictest confidence" [Para. 0023 of Publication 2005/0222869, which corresponds to the instant application]. In addition, Para. 0023 further states that "the expert never is provided with the ultimate

outcome or the resolution of the claim, thereby removing any potential for bias by that expert in evaluating future similar claims.” Consequently, the cited claim limitation is explicitly disclosed in the Specification of the instant application as filed.

As per claim 16, the Examiner asserts that the claim limitation “the expert is retained prior to the filing of any litigation by said retaining party or another party adverse to said retaining party” is not disclosed.

In reply, Applicant notes that the Background section of the Specification, Para 0006, notes that one objective of the present invention is to “overcome deficiencies with respect to current system,” which are described as “resulting in higher litigation and insurance costs.” In one aspect, in order to address this concern, the “Detailed Description” section, Para. 0024, describes that “the practice of the present invention also reduces the overall cost of resolving malpractice claims incurred by insurance carriers and incurred by consumers by facilitating the settlement of valid claims before . . . expensive litigation commences.” Since an expert must be retained before completion of the claimed processes of the present invention as described in claim 16, the expert must likewise have been retained prior to commencement of litigation in order to facilitate settlement of valid claims before litigation commences. Consequently, the Specification explicitly describes the assertedly deficient limitation of claim 16.

As per claim 17, the Examiner asserts that the claim limitation “said objective evaluation includes an objective monetary valuation of the claim” is not disclosed.

In reply, Applicant notes that the Specification, Paras. 0017-0018, states that the retained expert performs investigations, reviews and/or analysis and prepares a written report of findings and conclusions. In addition, Para. 0018 states that the expert prepares a written report "including, where appropriate, an evaluation of the claims worth in monetary terms." The experts report is specifically described as being "an independent, objective evaluation of the claim" [Para. 0017]. Moreover, the report is based on objective information and is further supported as being objective by included "references to supporting literature and other documentation where appropriate." Consequently, the Specification describes the claim limitation of providing an objective monetary valuation of the claim.

For at least the above-described reasons, Applicant respectfully submits that the Specification and Drawings of the present application, as filed, provide support for the assertedly deficient limitations of claims 14-17. Accordingly, the rejection of claims 14-17 under 35 U.S.C. § 112, first paragraph, is improper, and therefore Application respectfully requests they be withdrawn and claims 14-17 be allowed.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 5 and 26 under 35 U.S.C. § 112, second paragraph, as being assertedly indefinite.

More particularly, with respect to claim 5, the Examiner asserts that a statement that the standard of care was met and a statement that the standard of care was not met is indefinite. Specifically, the Examiner states that “[i]t is unclear how a standard can me [sic] and not met at the same time” [Office Action, page 3, 5th Full Paragraph].

In reply, Applicant notes that, in performing an objective evaluation of a claim, such as a medical malpractice claim, it is completely reasonable to assess the claim and provide arguments as to why the standard of care was met and was not met. In fact, Applicant respectfully notes that in many, if not most, litigation matters, the opposing parties will assert contrary positions, with one party taking a position that the standard of care was met and another taking a position that it was not met. Accordingly, in evaluation such a claim, particularly in an objective fashion as is described with respect to the present invention, it is clear that an objective evaluator can provide arguments for why the standard of care was met and was not met. Therefore, the claim language is not indefinite as asserted by the Examiner.

With respect to claim 26, the Examiner states that “the claim provides the limitation ‘assuming, for each board-certified [sic] who rendered care to the claimant, . . .’” [Office Action, page 3, 6th full paragraph].

In reply, Applicant notes that claim 26 does not include such language. However, Applicant believes that the Examiner may actually be referring to claim 25 rather than claim 26. Assuming this is the case, Applicant notes that the standard of care applicable to a physician who is board certified may be different than for a non-board certified physician

(such as, for example, comparing the standard of care of a board-certified ophthalmologist with that of a general practitioner), in which case the relevant standard of care for the board-certified physician would generally be higher. Accordingly, the language of claim 25, assuming that is the claim that the Examiner is referring to, is in fact definite because it requires the expert to consider the standard of care to be provided based on board certification.

For at least the above-described reasons, Applicant respectfully submits that claims 5, 25 and 26 are not indefinite. Accordingly, the rejection of claims 5 and 26 under 35 U.S.C. § 112, second paragraph, is improper, and therefore Applicant respectfully requests they be withdrawn and claims 5, 25 and 26 be allowed.

Claim Rejections Under 35 U.S.C. § 101

The Examiner has rejected claims 1-7 and 9-26 under 35 U.S.C. § 101 as being assertedly directed to non-statutory subject matter.

In reply, Applicant has amended claims 1 and 9 as listed previously in this paper to describe that the methods are computer-implemented methods, and further narrow one or more of the claimed steps such that they are tied to another statutory class (i.e., a computer).

Applicant further notes that in *Ex parte Dickerson*, BPAI Appeal 2009-001172 (July 9, 2009), the BPAI held that claims that recite a computerized method which includes a step

of outputting information from a computer is “tied to a particular machine or apparatus,” and is therefore statutory subject matter. *Id.* at page 16.

Consequently, in view of *Ex Parte Dickerson* and the amendments of claims 1 and 9, Applicant respectfully submits that claims 1 and 9, as well as their associated dependent claims, are statutory subject matter under 35 U.S.C. § 101. Accordingly, Applicant respectfully submits that the rejections be withdrawn and claims 1 and 9, as well as their associated dependent claims, be allowed.

Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 1 and 9-17 under 35 U.S.C. § 103(a) as being unpatentable over Walker et al., United States Patent No. 5,862,223, in combination with Rackman, United States Patent no. 5,903,646.

Walker Reference

Walker purportedly describes an expert matching method and apparatus for matching an expert having particular qualifications and an end user seeking a solution to a question or request provided to the expert, as well as managing communications between the end user and the expert and facilitating payment for services rendered by the expert [Abstract, Col. 6, line 55 – Col. 8, line 46].

Rackman Reference

Rackman purportedly describes an access control system for litigation document production where documents are produced and stored as images on an optical disk [Abstract]. It is important to note that while Rackman describes redacted documents as done in litigation, the redacted documents described by Rackman are redacted by a partisan party to a litigation matter, not a neutral third party, and the redacted information relates solely to either irrelevant, non-responsive information or attorney-client privileged information.

Differences Between Walker, Rackman and the Presently Claimed Invention

Aspects of the present invention as are described in, for example, claims 1 and 9, relate to a double blind method for eliminating actual and potential bias from a malpractice claim evaluation.

In one aspect, in order to facilitate elimination of bias, the claimed method describes that facts provided by a retaining entity are redacted by a neutral third party so as to prevent identification of any party involved in or having an interest in the claim by an expert retained to evaluate the claim. In addition, a further redaction step is described whereby the neutral third party further redacts, from a written claim evaluation provided by the expert, any information which would permit identification of the expert. These steps describe redaction of specific types of information by specific parties so as to implement the novel, claimed inventive double blind claims evaluation process. Neither Walker or Rackman, taken alone or in combination, describe these specific steps, nor do they suggest such a novel double blind evaluation process.

More specifically, Applicant notes that Walker says absolutely nothing about redaction of submitted documents, or in particular redaction done by a neutral third party so as to facilitate elimination of actual or potential bias by removal of specifically claimed types of information, by the neutral third party, associated with the identifications of parties or experts.

The Examiner acknowledges that Walker is deficient with respect to these claimed steps, and attempts to cure this deficiency by citing Rackman. As noted previously, Rackman is directed to an access control system for litigation document production, and indicates that redaction is performed by (or the redacted information provided to) a partisan (i.e., one of the opposing parties to the litigation) so as to preclude disclosure of "unrelated matters," or attorney-client "privileged" documents [Rackman, Col. 1, line 63-Col. 2, line 6].

As presently claimed, Applicant is not asserting the process of redaction is novel, but rather that redaction, done in the particularly claimed fashion and with respect to the particularly claimed information as part of a double-blind evaluation process, is both novel and non-obvious. Specifically, unlike Rackman, the presently claimed invention explicitly describes that redaction is done by a neutral third party, and for two particular purposes; precluding bias by removing the identities of parties to a matter, as well as precluding bias by removing the identities of any experts performing the evaluation.

While Rackman may describe redaction generally, it is specifically described as being done by a partisan, and for the completely different purposes of eliminating extraneous or non-responsive information or protecting attorney-client privileged

information. In either case, Rackman fails to describe the specifically claimed steps of "redaction by the third party . . . of all facts which would permit the expert to identify any party involved or having an interest in the claim," or "redaction by the third party from the written claim evaluation of any information which would permit identification of the expert." Consequently, while Rackman may describe that redaction may be done in the litigation context, it fails to describe the specifically claimed steps of the present invention.

In addition, Applicant notes that the teachings of Walker and Rackman are so different and distinct as to make their combination improper under 35 U.S.C. § 103(a).

More specifically, Walker describes that anonymity relates only to preventing the end user and/or expert from knowing the identify of each other [e.g., Col 10, lines 8-19]. As such, Walker merely suggests that it may be desirable to prevent the expert from knowing the identify of the end user (*i.e.*, retaining party) and/or preventing the end user from knowing the identify of the expert. Walker, however, goes no further than this, and says nothing regarding how such privacy is implemented other than that the names of the end user and/or retaining party may be withheld from each other [Col. 10, lines 19-26].

In addition, Walker says absolutely nothing about processing or editing the supplied information (*i.e.*, information as described and cited by the Examiner in Col. 7, lines 6-29) or specifically the third party redacting the supplied information to remove information permitting the expert from identifying any party involved in or having an interest in the claim. Rackman, on the other hand, describes that redaction is done to prevent providing of non-responsive or privileged information, by a partisan, in the litigation discovery process. Moreover, while the presently claimed invention addresses redaction so as to protect the

identities of parties (i.e. the claimant/retaining party or expert), any information disclosed or provided by Rackman is clearly identifiable as to source – which is the opposing party in the litigation.

Further, while the presently claimed invention teaches maintaining anonymity of the expert to provide a double-blind evaluation, Walker describes that identifying the expert and/or facilitating direct contact between the end user and the expert is desirable [e.g., Col. 7, lines 58-61 (“user is offered the opportunity to review the expert’s qualifications”), Col. 8, lines 5-8 (“the user will typically know the experts’ names but not their location or phone numbers”), Col. 8, lines 50-51 (describes an implementation with “the ability for the user to select from a particular list of experts prior to submitting his request”). As such, Walker teaches away from the present invention, as well as Rackman (which describes redaction of information), by teaching that it is frequently desirable to allow the end use to know the identity of experts and/or have the ability to select a particular expert prior to engaging the expert, and/or allow the end use to directly contact the expert.

In addition, as noted previously, Walker purportedly describes that a third party (i.e. the “on-line Exchange,” Col. 7, lines 7-10) performs the described functionality so as to obtain all relevant information about the question to be provided to the expert (i.e., a “full description of the job to be performed,” Col. 7, lines 10-11)), whereas Rackman purportedly describes that information that may be important and/or highly relevant, such as privileged information (Col. 2, lines 3-4) be withheld, and the redaction performed by a partisan rather than a neutral third party.

Therefore, for at least the above-described reasons, Walker and Rackman teach away from each other as well as the presently claimed invention; and, in any event, any combination of Walker and Rackman would result in an inoperative process. Consequently, Applicant respectfully submits that the combination of Walker and Rackman under 35 U.S.C. § 103 is improper. For at least these reasons, Applicant respectfully requests that the rejections of claims 1 and 9 be withdrawn and claims 1 and 9, as well as their associated dependent claims, be allowed.

With respect to claims 14 and 15, one aspect of the presently claimed invention as described in those claims relates to the limitation that the expert be precluded from obtaining any information regarding the outcome of the claim.

The Examiner acknowledges that the combination of Walker and Rackman fails to disclose this specific claim limitation, and attempts to cure this deficiency by asserting, apparently based on personal knowledge since no further reference is cited, that “it would have been obvious . . . to have the expert be precluded from obtaining any information regarding the outcome of the claim in order to maintain the integrity of the expert-based system by providing education expert opinions absent bias” [Office Action, page 9, 4th full paragraph].

Applicant respectfully disagrees with the Examiner’s assertion that this limitation would have been obvious. For any of a variety of reasons, it may be desirable that the expert be provided with at least some information regarding the outcome of the claim settlement, such as, for example, receiving information on the settlement monetary amount

or other settlement terms or receiving information on how the expert's analysis was received by the party in order to provide the expert with a score or feedback (which is specifically described as being desirable in Walker – *see, e.g.*, Col. 21, lines 53-61 where expert ratings, based on the perceived quality of the expert's work, is described). In addition, Walker further describes that this information may be used to rate and/or provide “written warnings” to experts when ratings (and associated expert performance, which can be correlated with outcome) drop below an established level. If anything, Walker suggests that it is desirable to provide at least some feedback to the expert on the outcome.

Consequently, for at least these reasons, Applicant respectfully submits that this limitation of claims 14 and 15 is not obvious as asserted by the Examiner, and therefore the rejection of claims 14 and 15 under 35 U.S.C. § 103 is improper. Applicant requests that, if the Examiner believes that this limitation is obvious, the Examiner provide a specific citation to relevant prior art that describes this limitation in a new, non-final office action.

With respect to claim 16, one aspect of the presently claimed invention as is described in that claim relates to the limitation of retaining an expert prior to the filing of any litigation. The Examiner asserts that this limitation is “non-functional descriptive material and that the Walker – Rackman combination “is fully capable of obtaining an expert prior to filing a litigation.”

Applicant respectfully asserts that the Examiner misconstrues this limitation of claim 16 and that this limitation is not non-functional descriptive material. Specifically, as is well known, both costs to parties and party posturing typically change after litigation is filed.

Moreover, as stated in the Specification of the present invention, it may be advantageous for both parties to a matter that may ultimately be litigated, such as an insurance claim, to receive an objective evaluation of the merits and downsides of their respective positions prior to filing litigation as opposed to evaluating the merits after litigation has been filed and the parties have dug in to their positions. Consequently, an inventive process as claimed may be particularly advantageous and provide unique functionality when performed prior to initiation of litigation as described in claim 16.

In addition, Applicant notes that Rackman is directed to addressing discovery problems and associated costs that inherently arise only after litigation has been filed. Consequently, Rackman specifically teaches away from this claimed limitation because it is directed to addressing cost considerations that can only arise after litigation is filed (i.e., there is absolutely no need for a process as described in Rackman until litigation is filed since Rackman is solely directed to the litigation discovery process).

Accordingly, for at least the above-described reasons, Applicant respectfully submits that the described limitation of claim 16 is not non-functional descriptive material, and therefore the rejection of claim 16 on this basis is improper.

With respect to claim 17, one aspect of the presently claimed invention as described in that claim relates to the limitation of providing an objective monetary evaluation of the claim. The Examiner asserts that this is merely non-functional descriptive material and that "the information contained in the objective valuation provided by the retaining party does

not change the function of the claimed invention” [Office Action, Page 10, 4th full paragraph].

Applicant respectfully asserts that the Examiner misconstrues this limitation of claim 17 and that this limitation is not non-functional descriptive information. Specifically, the presently claimed invention is directed towards a process of double-blind evaluation of a claim by providing an objective evaluation. However, such an objective evaluation may take many forms, and the resulting evaluation and report may include different types of information, all of which may serve different and distinct purposes. For example, one claimed element of such a report relates to identification of relevant standards of care (for example, claims 18 and 19). Another claimed element relates to an opinion as to whether the medical treatments have met (or not met) a particular standard of care (for example, claim 25). Others relate to a suggested course of treatment (for example, claim 24), or to an evaluation of the monetary value of the claim (for example, claim 17). As such, each of these items of information may have unique and specific relevance in the context of the claimed process and associated reports, and each of these types of information may serve different purposes in evaluating the ultimate outcome of the claim.

For example, an objective report describing that a treatment met a particular standard of care may have less relevance to a defendant if a separate evaluation of the potential value of the claim was very high – the high potential loss may incentivize the defendant to settle even if they are likely to prevail. Conversely, if an objective evaluation of the monetary value of the claim is low, the analysis regarding whether the standard of care is met or not met may be highly relevant to settling the claim. Consequently, the claimed step of

providing an objective monetary evaluation addresses a potentially distinct and independent element of a claim analysis and is therefore not non-functional descriptive material.

Accordingly, for at least the above-described reasons, Applicant respectfully submits that the described limitation of claim 17 is not non-functional descriptive material, and therefore the rejection of claim 17 on this basis is improper.

With regard to claims 5 and 22, one aspect of the presently claimed invention as is described in these claims relates to providing one or more arguments why the treatment rendered met the one or more applicable standards of care and one or more arguments why the treatment did not meet the applicable standards of care. Applicant believes that the Examiner misconstrues these claim limitations as shown by the rejection of claim 5 under 35 U.S.C. § 112. As noted previously in this paper, it may be desirable for an objective expert to provide arguments as to why the provided treatment both met the standard of care as well as arguments as to why the provided treatment did not meet the standard of care. Applicant notes that these limitations are specifically claimed in the conjunctive (i.e., “and”) not the disjunctive (i.e., “or”). However, the Examiner merely cites Medical Experts for the proposition that an expert would evaluate a standard of care only in the disjunctive – Page 1 of Medical Experts, as stated by the Examiner, merely says that the expert gives an opinion as to “whether the defendant’s conduct did or did not meet the standard” [Office Action, page 15, 1st full paragraph].

This is not, however, what is presently claimed in claims 5 or 22 – these claims specifically recite that the expert provides reasons as to why the treatment might have been

considered to meet the standard of care as well as to why the treatment might not have met the standard of care. Consequently, the Examiner's rejection of claims 5 and 22 is improper since, at a minimum, the cited reference, Medical Experts, fails to describe the claimed limitations. Accordingly, for at least this reason, Applicant respectfully requests that the rejections of claims 5 and 22 be withdrawn and the claims be allowed.

With respect to claim 24, one aspect of the presently claimed invention as described in that claim relates to the limitation of providing a description, by the expert, of a suggested course of treatment, and further where the description of the suggested course of treatment is provide without regard to the specific treatment described in the claim. The Examiner asserts that this is merely non-functional descriptive material and that "the description of a suggested course of treatment does not change the function of the claimed invention" [Office Action, Page 16, 3rd full paragraph].

Applicant respectfully asserts that the Examiner misconstrues this limitation of claim 24 and that this limitation is not non-functional descriptive information. Specifically, the presently claimed invention is directed towards a process of double-blind evaluation of a claim by providing an objective evaluation. However, such an objective evaluation may take many forms, and the resulting evaluation and report may include different types of information, all of which may serve different and distinct purposes. For example, one claimed element of such a report relates to identification of relevant standards of care (for example, claims 18 and 19). Another claimed element relates to an opinion as to whether the medical treatments have met (or not met) a particular standard of care (for example,

claim 25). Others relate to a suggested course of treatment or to a description of a proposed course of treatment (that the expert would have prescribed) independent of the actual treatment provided (for example, claim 24). As such, each of these items of information may have unique and specific relevance in the context of the claimed process and associated reports, and each of these types of information may serve different purposes in evaluating the ultimate outcome of the claim.

For example, a description of a suggested course of treatment may be compared to an actual course of treatment to assess results, or to provide an alternate treatment approach, or to evaluate divergence in patient condition based on the actual treatment versus the suggested treatment. Such information is distinct and independent from other information provided in the course of evaluation, and therefore potentially addresses a distinct and unique concern regarding patient outcome as well as potential settlement terms, such as additional treatment or ultimate monetary value of the claim. Consequently, the claimed step provides a distinct function and is therefore not merely non-functional descriptive material.

Accordingly, for at least the above-described reasons, Applicant respectfully submits that the described limitation of claim 24 is not non-functional descriptive material, and therefore the rejection of claim 24 on this basis is improper.

Concluding Comments

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims, including any cancelled claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim except as specifically stated in this paper.

Applicant respectfully requests consideration of the remarks herein prior to further examination of the above-identified application. The undersigned would of course be available to discuss the present application with the Examiner if, in the opinion of the Examiner, such a discussion could lead to resolution of any outstanding issues.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

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